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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,733	09/04/2003	Emrys J. Williams	5681-20500	7364

35690 7590 04/06/2007 MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C. P.O. BOX 398 AUSTIN, TX 78767-0398	**EXAMINER** AGWUMEZIE, CHARLES C	

ART UNIT	PAPER NUMBER
3621	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/654,733	WILLIAMS, EMRYS J.
	Examiner	Art Unit	
	Charlie C. Agwumezie	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 September 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>12/22/03</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgement

1.   In view of Applicant's argument filed on March 8, 2007 coupled with the

telephone conversation today being 3/30/2007, the **finality** of office action mailed on

January 16, 2007 and advisory action mailed on March 22, 2007 is hereby withdrawn

and substituted with this non-final office action.

Status of Claims

1.   Claims 1, 9, 15, 16, 26 and 39 are amended. Claims 1-39 are pending in this

application per the response to office action filed on October 26, 2006.

Response to Arguments

2.   Applicant's arguments with respect to claims 1-39 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

Claims 1-3, 7-11, 14-16, 26-34, 36-37, and 39, are rejected under 35

U.S.C. 102(e) as being anticipated by Walker et al U.S. Patent Application Publication

No. 2006/0218098 A1.

As per **claims 1, 9, 15, and 16**, Wlaker et al discloses an Apparatus for use in

transactions, comprising:

non-volatile memory containing a set of multiple identifiers associated with a

same customer account, wherein said multiple identifiers are also known to an agency

providing said customer account (fig. 1; 0025; 0026; "...plurality of predetermined

single-use financial account identifiers..."), and

a processor operable to select for each of a plurality of transactions involving the

same customer account, a different identifier from said set of multiple identifiers for use

with the respective transaction (fig. 1; 0023; 0047; 0049; "...the encryption data

changes for each use of the card so that ... card number is different for each

transaction...").

As per **claim 2, and 10**, Walker et al further discloses the apparatus, wherein

each of the identifiers in said set of multiple identifiers is allocated by the agency

uniquely to the apparatus (figs. 1 and 10; 0049; 0093; "...instructing card holder to

obtain a new device with list of single-use credit card numbers...").

As per **claims 3 and 11**, Walker et al further discloses the apparatus, further

comprising a communications facility to engage a terminal, wherein the apparatus is

operable to receive bill details for a transaction from the terminal, to generate a

transaction record from the bill details, and to transmit the transaction record to the

terminal (figs. 3 and 4; 0054; 0096).

As per **claim 4 and 12**, Walker et al further discloses the apparatus, wherein the

transaction record includes a digital signature that is generated using a cryptographic

key contained within the non-volatile memory (0023; 0042; 0065; 0066).

As per **claim 5 and 13**, Walker et al further discloses the apparatus, wherein

the transaction record is encrypted (0009; 0023).

As per **claim 7**, Walker et al further discloses the apparatus, wherein said

apparatus is operable to engage a first class of terminals for making a transaction, and

a second class of terminals to enter or to update account information stored in the non-

volatile memory (fig. 3 and 4; 0093).

As per **claim 14**, Walker et al further discloses the method, further comprising

limiting the transaction rate of the device to prevent rapid read-out of the identifiers

(0046).

As per **claims 17 and 20**, Walker et al discloses a method for opening an

account on a portable transaction device comprising:

opening an account record in an agency computer system, wherein said agency

is to provide the account (fig. 10; 0047; 0093; "...instructing cardholder to obtain a new

device with a new list of single use credit card umbers..."),

generating a set of multiple identifiers to be used for transactions on the account

(0049; 0093),

storing the set of multiple identifiers in the agency computer system (0093;

0097), and

storing the set of multiple identifiers on the portable transaction device (fig. 10;

0093; 0097).

As per **claim 18**, Walker further discloses the method, wherein the identifiers are

unique to the account for the agency (0046; "...the number is unique for the specific

input variable...").

As per **claim 19**, Walker et al further discloses the method further comprising

adding the identifiers to an index, wherein said index maps from an identifier to the

corresponding account (0047; 0097; "...transmitted credit card number matches listed in

the credit card database...").

As per **claim 21**, Walker et al discloses the method wherein the identifier within

said set of multiple identifiers are unrelated to one another (0046)

As per **claim 22**, Walker et al further discloses the method, wherein the
identifiers are generated on the agency computer system, and are transmitted to the
portable transaction device for storage thereon (fig. 10, 0047; 0093).

As per **claim 23**, Walker et al further discloses the method, further comprising
generating at least one cryptographic key for use with the account (fig. 1).

As per **claim 25**, Walker et al further discloses the method, further comprising
establishing an identity of a person who is to hold the account prior to opening the
account (fig. 10; 0097).

As per **claim 26**, Walker et al discloses a method for performing a transaction at
a terminal using a portable transaction device, comprising:

generating a bill for the transaction at the terminal (0045; 0097; "…cardholder
uses device to generate transaction specific data…"),

engaging the portable transaction device with the terminal (figs. 3 and 4; 0047),

transmitting the bill from the terminal to the transaction device (0045; …uses
device to generate transaction specific data…),

selecting for each of a plurality of transactions involving a same customer
account, a different identifier from a set of multiple identifiers stored on the transaction

device for use in the transaction (fig. 1; 0023; 0047; 0049; "...the encryption data

changes for each use of the card so that ... card number is different for each

transaction..."),

generating a transaction record on the transaction device, the transaction record

incorporating information from the bill and the selected identifier (0045; ...uses device to

generate transaction specific data...), and

transmitting the transaction record to the terminal (figs. 3 and 4; 0045; 0047;

"...transmits the single use number to the merchant...").

As per **claim 27**, Walker et al further discloses the method, wherein the

transaction record includes a digital signature from the transaction device (0023; 0042).

As per **claim 28**, Walker et al further discloses the method, wherein the

transaction device is associated with a customer account, and wherein said multiple

identifiers are also known to an agency providing said customer account, the method

further comprising:

transmitting the transaction record from the terminal to an agency computer

(0047; "...merchant enters the single use number into authorization terminal connected

to a central credit card processing system..."),

accessing an account record for the customer account based on the selected

identifier included in the transaction record (0047; "...central system processor

maps...card number onto conventional credit card account..."),

validating the transaction (0047; "...determines whether the transaction is

authorized..."), and

updating the account record in respect of the validated transaction (0093;

"...updated to change the status of the number from not used to used...").

As per **claim 29**, Walker further discloses the method, wherein prior to

transmitting the transaction record from the terminal to the agency computer, the

terminal incorporates its own copy of the bill into the transaction record (0045; 0047).

As per **claim 30**, Walker et al further discloses a method of operating a computer

account system at an agency, said agency maintaining a plurality of customer accounts

on the computer account system, wherein each customer account has a set of multiple

identifiers associated therewith, the method comprising:

receiving a request for a transaction on a customer account (0045; 0047),

accessing an identifier within the request (0047),

determining which set of multiple identifiers the accessed identifier belongs to,

and from this determining a customer account for the transaction (0047), and

updating the determined customer account in respect of the transaction (0093).

As per **claim 31**, Walker et al further discloses the method, wherein determining

which set of multiple identifiers the accessed identifier belongs to comprises accessing

an index that maps identifiers to corresponding account records (0047; "...central

system processor maps...card number onto conventional credit card account...").

As per **claim 32**, Walker further discloses the method, wherein the request includes a digital signature generated by a transaction device associated with a customer account, and the method further comprises validating the digital signature (0023; 0042).

As per **claim 33**, Walker et al further discloses the method, further comprising

opening a new customer account by: creating a new account record for the new customer account (fig. 10; 0093), and

storing a set of multiple identifiers associated with the new customer account into the new account record (fig. 10; 0093).

As per **claim 34**, Walker et al further discloses the method, further comprising:

generating the set of multiple identifiers associated with the new customer account (fig. 10; 0093), and

transmitting the generated set of multiple identifiers to a customer transaction device for use with the new customer account (fig. 10; 0093).

As per **claim 35 and 38**, Walker et al further discloses the method, further comprising generating at least one cryptographic key for use in communications between the computer account system and the customer transaction device (fig. 1).

As per **claims 36 and 39**, Walker et al discloses a computer account system at an agency, said system comprising:

a plurality of customer account records, wherein each customer account record incorporates a set of multiple identifiers associated therewith (fig. 1; 0025; 0026; "...plurality of predetermined single-use financial account identifiers..."), and

an index that maps identifiers to corresponding account records (0047; "...central system processor maps...card number onto conventional credit card account..."),

wherein the system is responsive to receiving a request for a transaction on a customer account to access an identifier within the request in order to determine which set of multiple identifiers and hence which customer account the accessed identifier belongs to (0047; "...central system processor maps...card number onto conventional credit card account...").

As per **claim 37**, Walker et al further discloses the system, wherein the multiple identifiers associated with a customer account record are unique to that account record (0046; "...the number is unique for the specific input variable...").

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6, is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker

et at U.S. Patent Application Publication No. 2006/0218098 A1 in view of Mann, III et al

U.S. Patent Application Publication No 2006/0122943 A1.

As per **claim 6**, Walker et al failed to explicitly disclose the apparatus, wherein

said apparatus is provided within inert packaging to allow implantation into the human

body.

Mann, III et al discloses the apparatus, wherein said apparatus is provided within

inert packaging to allow implantation into the human body (0042; 0051).

Accordingly it would have been obvious to one of ordinary skill in the art at time

of applicant's invention to modify the method of Walker et al and incorporate the

apparatus, wherein said apparatus is provided within inert packaging to allow

implantation into the human body as taught by Mann, III et al in order to ensure

adequate security.

5.   **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et

at U.S. Patent Application Publication No. 2006/0218098 A1 in view of Pitroda U.S.

Patent Application Publication No. 2005/0247777 A1.

As per **claim 8**, Walker et al failed to explicitly disclose the apparatus, further

comprising first and second power circuits that are activated by said first and second

class of terminals respectively, wherein activation of said second power circuit does not

allow account information to be entered or updated in at least certain portions of said

non-volatile memory.

Pitroda discloses the apparatus, further comprising first and second power

circuits that are activated by said first and second class of terminals respectively,

wherein activation of said second power circuit does not allow account information to be

entered or updated in at least certain portions of said non-volatile memory (see figs. 3;

0014).

Accordingly it would have been obvious to one of ordinary skill in the art at time

of applicant's invention to modify the method of Walker et al and incorporate the

apparatus, further comprising first and second power circuits that are activated by said

first and second class of terminals respectively, wherein activation of said second power

circuit does not allow account information to be entered or updated in at least certain

portions of said non-volatile memory in view of the teachings of Pitroda in order to

ensure adequate security.

6.   **Claim 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker

et at U.S. Patent Application Publication No. 2006/0218098 A1 in view of Wynn U.S.

Patent No. RE38,137 E.

As per **claim 24**, Walker et al failed to explicitly disclose the method, further

comprising making a prepayment onto the account prior to using the account for

transactions.

Wynn further discloses the method, further comprising making a prepayment

onto the account prior to using the account for transactions (fig. 10).

Accordingly it would have been obvious to one of ordinary skill in the art at time

of applicant's invention to modify the method of Walker et al and incorporate the

apparatus, further comprising making a prepayment onto the account prior to using the

account for transactions in view of the teachings of Wynn in order to ensure adequate

available credit.

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to Wynn U.S. Patent No. RE38,137 E is a document considered relevant to the claimed invention.

 Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art ad are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.
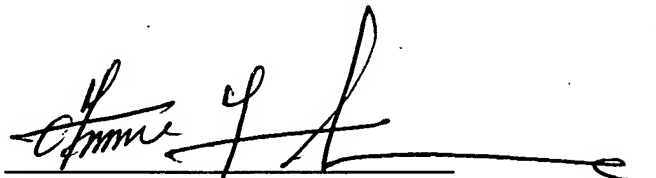
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on **(571) 272 – 6779**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

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Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charlie Lion Agwumezie
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March 21, 2007

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